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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,730	07/03/2001	Takashi Yasujima	49275-061	8172

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary	Application No.	Applicant(s)
	09/897,730	YASUJIMA ET AL.
	Examiner	Art Unit
	Jonathan ML Foreman	3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 July 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 11-14 is/are allowed.
- 6) Claim(s) 1 and 5-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

- (e) the invention was described in—
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 6,280,396 to Clark.

In reference to claims 1 and 8, Clark discloses a bioelectrical impedance measuring apparatus (Figure 1) comprising: a housing (22) (12) (14), a plurality of rod-like electrode members (24 and 26) having a plurality of rod-like electrodes (24a, b and 26a, b) disposed in an upper part (22) of said housing, the upper housing having two side edges, the rod-like electrodes being arranged and fixed lengthwise along both side edges of the upper housing. The electrode members have a shape and length such that an error derived from a change in posture caused by a difference in height, for example persons of differing heights such as 6'-1" and 6'-1.25", can be minimized. Clark discloses a display device (42) having the capability of an operator panel (36) that lies between the electrode members (24 and 26). Col. 5, lines 14 – 17 disclose a touch-screen display for use with the apparatus. The apparatus disclosed by Clark also comprises a weighing device (Col. 4, lines 22 - 24) in the lower part (12) of the housing. The housing accommodates: (Figure 4) a current supplying device (32), a voltage measuring device (34) and an arithmetic means (40) for calculating a bioelectrical impedance value from the supplied current value and the measured voltage values; a modem; and a display device for displaying information which is acquired over an internet accessed through the modem (Col. 8, lines 9 – 18).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,280,396 to Clark as applied to claims 1 and 8 above, and further in view of U.S. Patent No. 6,478,736 to Mault.

In reference to claims 5, Clark discloses a bioelectrical impedance measuring apparatus comprising a display, but does not teach displaying a diet or medicine that is selected based on a percent body fat from the bioelectrical impedance value. However, Mault discloses a bioelectrical impedance measuring apparatus comprising a display capable of displaying a diet or medicine that is selected based on a percent body fat from the bioelectrical impedance value (Col. 10, lines 5 – 51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the display as disclosed by Clark to have the capabilities of displaying a diet or medicine as taught by Mault in order to provide the user feedback in terms of foods to consume and foods to avoid (Col. 10, lines 48 – 51).

In reference to claim 9, Mault teaches the device being accessible at different locations (Col. 12, lines 66 – 67) and displaying information related to exercise and fitness (Col. 11, lines 36 – 57) based on a percent body fat from the bioelectrical impedance value. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include information introducing a sporting or esthetic club, in order to provide the user with a location for performing the exercise program designed for the user.

6. Claims 6, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,280,396 to Clark in view of U.S. Patent No. 6,478,736 to Mault as applied to claims 5 and 9 above, and further in view of U.S. 6,370,513 to Kolawa et al.

In reference to claims 6, 7 and 10, Kolawa et al. discloses an apparatus comprising a modem, being located in a store (Col. 12, lines 31 – 34), displaying inventories of the diet or medicine in another franchised store acquired over an internet accessed through the modem. The apparatus displays a location of the diet or medicine, a price, and an inventory thereof (Col. 13, lines 21 – 39). Kolawa et al. further discloses that information displayed on the device can be created with the help of a dietitian (Col. 15, lines 43 – 44). It would have been obvious to one having ordinary skill in the art to combine the database and item locating capabilities of the apparatus as taught by Kolawa et al. to the apparatus as disclosed by Clark in view of Mault in order to enable the user to easily find items suggested by the dietitian.

Allowable Subject Matter

Claims 11 – 14 are allowed. No prior art teaches or fairly suggests a plurality of rod-like electrode members extending outwardly from the two side edges of an upper housing and extending in an arc-shape over the top surface of the upper housing.

Response to Arguments

Applicant's arguments filed 6/9/04 have been fully considered but they are not persuasive. Applicant has asserted that Clark fails to disclose the electrodes having a shape and length such that an error derived from a change in posture caused by a difference in a height can be minimized. However, it is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, i.e., a functional limitation, does not impose any structural limitation upon the claimed apparatus which differentiates it from

a prior art reference disclosing the structural limitations of the claim. *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963). Where the prior art reference is inherently capable of performing the function described in a functional limitation, such functional limitation does not define the claimed apparatus over such prior art reference, regardless of whether the prior art reference explicitly discusses such capacity for performing the recited function. *In re Ludtke*, 441 F.2d 660, 169 USPQ 563 (CCPA 1971). The limitation “such that an error derived from a change in posture caused by a difference in a height can be minimized” is a functional limitation related to the electrodes. The electrodes as disclosed by Clark are capable of performing such a limitation. As the Examiner has pointed out, a change in height can be considered to be as little as $\frac{1}{4}$ inch. In such a situation, the electrodes as disclosed by Clark are capable of minimizing what minimal error there would be caused by the change in posture related to the difference in height. Additionally, Applicant has asserted that the references relied upon in the 35 U.S.C. 103(a) rejections provide no teaching, suggestion, or motivation to modify the apparatus of Clark to produce the claimed invention. However, the Examiner disagrees and maintains that the motivation to combine can be found either explicitly or implicitly in the references at the locations cited above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (703) 305-5390. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703)308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMLF



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